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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,119	05/11/2006	Rainer Gendermann	4441.76213	4889
24978 7590 01/07/2010 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
HSIAO, JAMES K				
ART UNIT		PAPER NUMBER		
3657				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,119

Applicant(s)

GENDERMANN, RAINER

Examiner

JAMES K. HSIAO

Art Unit

3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 18, 19, 21, 24 and 29-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 20, 22, 23, 25-28, and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/22/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 18, 19, 21, 24, 29-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/23/2009.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16, 17, 20, 22, 23, 25-28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rotter et al. (5351664) in view of Glueck (DE19654365).

Regarding claims 16 and 32, Rotter et al. discloses a carrier (fig 1) element that can be attached to an engine block (11) and capable of carrying an oil filter and oil cooler (figs 1-2). The oil module is provided with channels (41, 42) for guiding oil and water and a bypass channel (36) for bypassing the oil cooler.

Rotter lacks an oil cooler base plate. Glueck teaches an oil cooler base plate (14) forming a portion of the oil cooler (fig 3) and occluding the oil cooler on a carrier side (fig 3), wherein at least a main part of the oil cooler bypass channel (18) extends through the oil cooler base plate (fig 5) and is sealed towards at least one of an outside

environment on the oil cooler side by the remaining oil cooler and on the carrier element side by the carrier element (figs 3 and 5).

Regarding claim 17, Glueck teaches wherein the bypass channel is formed by at least one slit (18, fig 5) extending over an entire thickness of the plate (14), see fig 3, and thickness of 14.

Regarding claim 20, see figure 5 of Glueck, middle section (18) and shorter sections (near 10 and 10').

Regarding claims 22 and 23, Glueck teaches wherein the channel 18 is throttled (fig 5, b).

Regarding claim 25, Glueck teaches wherein the cross-sectional narrowing is formed by at least one overlapping area (fig 1-3) between one end of the oil cooler bypass channel (14) and a channel area on the carrier element side (15) being connected with one of the oil inlet and oil outlet of the oil cooler (figs 1-3). As broadly recited, the limitation "overlapping area" is given the broadest reasonable interpretation of being any structure or portion thereof that may overlap the channel (18).

Regarding claims 26 and 28, Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. In this case, the structure is the base plate and the process by which it was created is the stamping.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cooler of Glueck with the oil module of Rotter

because substituting known structure that yields the same predictable result of cooling requires only routine skill in the art.

Regarding claim 27, Rotter and Glueck disclose as set forth above but lack an aluminum material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use aluminum as a preferred material since it has been held to be within the general skill of a worker to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jonsson, Osborne, Patel, Olson, Holman, and Gruner were all used during examination but were not relied upon for rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES K. HSIAO whose telephone number is (571)272-6259. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley T King/
Primary Examiner, Art Unit 3657

JKH